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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,229	09/12/2003	Joseph R. Hedrick	0112300-612	6841
29159	7590	04/28/2006	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			SAGER, MARK ALAN	
			ART UNIT	PAPER NUMBER
			3712	
DATE MAILED: 04/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/661,229

Applicant(s)

HEDRICK ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/3/06</u> . | 6) <input type="checkbox"/> Other: _____  |

***Allowability Withdrawn***

1. The indicated allowability of claimed features pertaining to originally filed claims 8-9, 14-23, 52-58 and 86 is withdrawn in view of the reconsideration of the reference(s) to Takemoto, 5683082. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 72-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language a 'separate recording member connected to the body' is confusing where if the cited language refers to structure not on or in card/body at least due to the language 'connected to' being not of the card/body or due to the language 'separate' being not of the card/body claim while the preamble stating a data card comprising. Thus, the claim scope is indefinite. For examination purposes only, the claim is interpreted as thermosensitive recording section/member on the card/body.

***Claim Rejections - 35 USC § 102/103***

4. Claims 1-24, 38-69, 71 and 82-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Takemoto et al (5683082) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takemoto et al (5683082) in view of Takemoto (5628685). Takemoto '082 discloses a gaming device, data card, data storage device and method comprising all claimed features/steps of cited claims, as amended, including a housing (fig. 3), a game operable upon a wager (4:30-35, 7:49-8:59), a read-write device (ref. 29), a card transporter (7:49-8:39, 12:1-23), a processor

(ref. 14) and a memory device (ref 6, 12) where the game memory includes a disk that is magnetic, optical, CD-ROM or tape (4:36-41). Takemoto '082 further states to dispense an adjustment card such as to register (magnetically record or print) input remaining amount on a predetermined card (if the player inputs a card in place of cash, on that card; if the player does not input a card, on a card held in the card stack section of the card processor 5a) thus teaching storing instruction to cause re-settable data card to be stored within the housing after a designated event occurs, whereby following different events the processor causes one of the data cards to be dispensed to a player and a different one of the re-settable data cards to be reset and stored in the housing, determine whether any credits remain, store the received data card within the housing if no credits remain and if credits remain, cause the data on the received data card to correspond to remaining credits and dispense the data card to the player, move the received card to a card holder, retrieve a data card from the card holder, dispense the received data card to the player if a designated event occurs and store the received data card within the housing if another designated event occurs, as particularly claimed. Takemoto '685 (6:23-28, 53-58, 7:11-8:28, 9:23-55, 11:26-45, 13:23-55) is provided as evidence of enablement within Takemoto '082 or to show that a characteristic not present in Takemoto '082 is inherent regarding dispensing or storing/holding data card upon differing events such as cash-out or zero balance. MPEP 2131.01. Essentially, Takemoto '082 either records/prints adjustment value upon a stored card from card stack where the play began with cash inserted or records/prints adjustment value upon the received card being mechanically held where play began from an inserted data card upon receipt of a cash-out or adjustment switch activation as predetermined event, but either does not provide a card upon a zero balance or retains received card upon a zero balance. Takemoto '685

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is submitted as evidence to show enablement within Takemoto '082 or to show that a characteristic not present is inherent in Takemoto '082 (sic).

Alternatively, where Takemoto '082 lacks instruction to store data card within the housing after a designated event such as a zero balance, as particularly claimed. Takemoto '685 discloses a gaming device, data card, data storage device and method that either does not provide a card upon a zero balance or retains received data card upon a zero balance (6:23-28, 53-58, 7:11-8:28, 9:23-55, 11:26-45, 13:23-55) thus teaching storing instruction to cause re-settable data card to be stored within the housing after a designated event occurs, whereby following different events the processor causes one of the data cards to be dispensed to a player and a different one of the re-settable data cards to be reset and stored in the housing, determine whether any credits remain, store the received data card within the housing if no credits remain and if credits remain, cause the data on the received data card to correspond to remaining credits and dispense the data card to the player, move the received card to a card holder, retrieve a data card from the card holder, dispense the received data card to the player if a designated event occurs and store the received data card within the housing if another designated event occurs, as particularly claimed. The process of not returning a zero balance card to a user is further taught in department store gift card where upon use to a zero balance the gift card is retained by respective department store as an accounting and business process. Thus, it would have been obvious to an artisan at a time prior to instant invention to add storing instruction to cause re-settable data card to be stored within the housing after a designated event occurs, whereby following different events the processor causes one of the data cards to be dispensed to a player and a different one of the re-settable data cards to be reset and stored in the housing, determine whether any credits remain,

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store the received data card within the housing if no credits remain and if credits remain, cause the data on the received data card to correspond to remaining credits and dispense the data card to the player, move the received card to a card holder, retrieve a data card from the card holder, dispense the received data card to the player if a designated event occurs and store the received data card within the housing if another designated event occurs, as particularly claimed, as taught by Takemoto '685 to Takemoto '082 to either not provide a card upon a zero balance or to retain a received data card having a zero balance as an accounting or business or security practice.

Issuance of a zero balance data card decreases security while increasing cost of card system since a user may discard a zero balance card if one were issued at least due to no game device may be activated from such a card until a positive balance is added. A discarded zero balance card increases cost of card system at least due to lost of re-use of card but also due to increasing opportunity for fraud. A discarded zero balance card would decrease security since anyone may obtain the discarded card from trash to attempt to increase its value illegally such as by fraud. Thus for accounting, business or security reasons, a zero balance card would not be issued.

5. Claims 25-37, 70 and 72-81 are rejected under 35 U.S.C. 102(b) as anticipated by Takemoto ('082) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takemoto ('082) in view of Sarbin (5179517) or, in the alternative, as being unpatentable over Takemoto ('082) in view of Takemoto ('685) as applied to claims above, and further in view of Sarbin. Takemoto ('082) or Takemoto ('082) in view of Takemoto ('685) discloses a game apparatus using a re-settable card as claimed including a magnetic card or a re-usable card such as a thermosensitive recording member (supra) including having a card memory and a processor. Takemoto's '082 card or Takemoto's '082 card in view of Takemoto '685 includes a card memory and a processor

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as is so well known as is commonplace, for example in smart or IC cards, for providing processing and a card memory capability on the card so as to relieve some of the processing and storage duties from a game device or system since some of the storing and processing is done by/on the card. Sarbin is provided as evidence of enablement within or, to show that a characteristic not present is inherent in Takemoto '082 or within Takemoto '082 in view of Takemoto '685 regarding memory, processor and storing/determining of designation on a data card such as smart card or IC card. MPEP 2131.01. Alternatively, if Takemoto's '082 card or, Takemoto's '082 card in view of Takemoto '685 lacks having a card memory and a processor or to store data 'associated with a presence of a designated condition' and to determine whether the designated condition is present as particularly claimed. However, a storage card such as smart card or IC card having a card memory and a processor for storing/determining a designation of a condition is well known as taught by Sarbin (2:10-3:15, 3:50-4:18, 7:8-27, figs. 1-7). Thus, it would have been obvious to a routineer in the art at a time prior to the invention to add card memory, processor and to 'store data associated with a presence of a designated condition' and to 'determine whether the designated condition is present', as particularly claimed, as taught by Sarbin to Takemoto's ('082) card or, alternatively to Takemoto's ('082) card in view of Takemoto ('685) in game apparatus so as to distribute/manage smart cards as well due to their popularity of use and so as to permit some processing duties to be performed by the card so as to lessen processing duties on gaming machine as inherent to smart card.

6. Claims 1-19, 22-24, 38, 44-45, 51-52, 58-59, 65-69 and 82-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Takemoto (5628685). Takemoto '685 discloses a gaming device, data card, data storage device and method comprising all claimed features/steps (figs. 1-

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9) of cited claims, as amended, including a housing (fig. 1-3), a game operable upon a wager (6:53-58), a read-write device (ref. 25, 26), a card transporter (7:20-8:24, 9:23-55, 10:37-47, 11:26-58, 13:23-55), a processor (ref. 40, 28) and a memory device (ref 28a), and further teaches dispensing or storing/holding data card upon events such as cash-out or zero balance (supra).

7. Claims 20-21, 39-43, 46-50, 53-57 and 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto '685 in view of Takemoto '082. Takemoto '685 discloses a gaming device, data card, data storage device and method comprising all claimed features/steps but lacks having a plurality of read-write devices or a plurality of hold devices or disk as particularly claimed. Takemoto '082 discloses a similar device, card and method teaching a plurality of read-write devices or plurality of hold devices so as to permit many forms of memory cards to be processed or disk as particularly claimed. Claimed forms of disk are conventional. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a plurality of read-write devices or a plurality of hold devices or disk as claimed, as taught by Takemoto '082 to Takemoto '685 gaming device, data card, storage device and method to permit processing of many forms of memory devices and to permit storage on conventional devices.

8. Claims 25-37, 70 and 72-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto '685 in view of Sarbin. Takemoto '685 discloses a gaming device, data card, data storage device and method comprising all claimed features/steps but lacks having a card memory and a processor or to store data 'associated with a presence of a designated condition' and to determine whether the designated condition is present as particularly claimed. However, a storage card such as smart card or IC card having a card memory and a processor for storing/determining a designation of a condition is well known as taught by Sarbin (2:10-3:15,



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3:50-4:18, 7:8-27, figs. 1-7). Thus, it would have been obvious to a routineer in the art at a time prior to the invention to add card memory, processor and to 'store data associated with a presence of a designated condition' and to 'determine whether the designated condition is present', as particularly claimed, as taught by Sarbin to Takemoto's ('685) gaming machine so as to distribute/manage smart cards as well due to their popularity of use and so as to permit some processing duties to be performed by the card so as to lessen processing duties on gaming machine as inherent to smart card.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-93 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eason discloses apparatus for issuing IC card; while, Jagielinski discloses a magnetically encoded card.

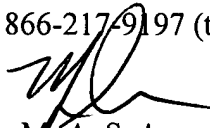
11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. A. Sager  
Primary Examiner  
Art Unit 3712

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